

REMARKS

Claims 1-29 are pending. Claims 1 and 15 are in independent form. Favorable reconsideration and further examination are respectfully requested.

Submitted herewith is a Request for Continued Examination pursuant to 37 C.F.R. § 1.114. Both the Reply filed April 27, 2006 and the present Supplemental Reply are submissions under 37 C.F.R. § 1.114(c). For the sake of brevity, Remarks made in the Reply filed April 27, 2006 are not repeated but rather incorporated herein by reference. This Supplemental Reply solely addresses the points raised in the Advisory Action mailed May 19, 2006.

Rejections under 35 U.S.C. § 101

In the Office action mailed February 28, 2006 (hereinafter "the Office action"), claims 1-29 were rejected under 35 U.S.C. § 101 as allegedly drawn to non-statutory subject matter. The Advisory action mailed May 19, 2006 (hereinafter "the Advisory action") is understood to indicate that the rejection would be upheld.

As a threshold matter, applicant notes that twenty nine claims were rejected as a single unit. Moreover, the alleged grounds for the rejections of all twenty nine claims are so clearly inapplicable to individual claims within that unit that Applicant is unable to formulate a response to the rejections. For example, it is self-evident that the method recited in claim 1 is not a "material," much less a "functional descriptive material," as contended in both the Office action and the Advisory action. Another example is the bald assertion that "claims 1-29 do not produce a result at all." Claim 2 recites establishing machine-readable instructions for changing a first

representation of the data variable information to a second representation of the data variable information. Applicant is at a loss to understand how the establishment of such machine-readable instructions are not a "result" within any meaning of the word.

37 C.F.R. § 1.104(2) requires that the reasons for any adverse action be stated in an Office action. This is fully consonant with the Interim Guidelines for Examination of Patent Applications cited in the Advisory Action, which directs Examiners that "each claim should be reviewed for compliance with every statutory requirement" and indicates that "USPTO personnel should state all reasons and bases for rejecting claims... Deficiencies should be explained clearly, particularly when they serve as a basis for the rejection." *See Interim Guidelines*, page 3 (emphasis added).

Applicant respectfully submits that the rejections of claims 1-29 under 35 U.S.C. § 101 are facially deficient for failing to actually state a reason for the rejections. Equivocations of methods with materials and bald assertions that none of the claims produce any result when this is clearly not the case do not allow applicant to judge the propriety of continuing the prosecution and are insufficient to meet the requirements for a valid rejection. As stated by Judge Plager in his concurring opinion in *In re Oetiker*:

"The process of patent examination is an interactive one ... The examiner cannot sit mum, leaving the applicant to shoot arrows into the dark hoping to somehow hit a secret objection harbored by the examiner. The '*prima facie* case' notion, the exact origin of which appears obscure ..., seemingly was intended to leave no doubt among examiners that they must state clearly and specifically any objections (the *prima facie* case) to patentability, and give the applicant fair opportunity to meet those objections with evidence and argument. To that extent the concept serves to level the playing field and reduces the likelihood of administrative arbitrariness." *In re Oetiker*, 977 F.2d 1443, 1449 (Fed. Cir. 1992)

Accordingly, Applicant requests that the rejections of claims 1-29 under 35 U.S.C. § 101 either be explained or be withdrawn.

Further, the Advisory action acknowledges that the mapping recited in claim 1 “might be a data transformation” but yet concludes that such mapping is excluded from patentability as “definitely not a physical [sic] transformation.” However, the fact that claim 1 is not a physical transformation is not a sufficient basis to exclude claim 1 from patentability. The citation to the *State Street Bank* decision included in the response filed April 27, 2006 explicitly states that “data transformations” are patentable subject matter when they are “a practical application,” i.e., not a mathematical algorithm or a law of nature. This is fully consistent with the Interim Guidelines for Examination of Patent Applications, which states that “physical transformation ‘is not an invariable requirement, but merely one example of how a mathematical algorithm [or law of nature] may bring about a useful application.’” See *Interim Guidelines*, page 20 (citing *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358-59 (Fed. Cir. 1999)) (emphasis added).

Once again, the rejection has set forth no basis for believing that the data transformations recited in claim 1 are anything other than a practical application. The practical applicability of the mapping recited in claim 1 is clearly set forth in the Background of the Specification. Moreover, as discussed above, for the rejection to be maintained, the burden is on the Office to establish that claim 1 is a mathematical algorithm, a law of nature, or other class excluded from being statutory subject matter without a practical application. This burden has not been met.

Accordingly, Applicant requests that the rejections under 35 U.S.C. § 101 of claim 1 and the claims dependent therefrom be withdrawn.

Rejections under 35 U.S.C. § 112

Claims 1-14 and 22-25 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to provide sufficient written description to satisfy the enablement requirement. In particular, the rejection contends that the specification lacks a basis for the recitation of "in the absence of input from a user regarding how the data variable information is to be mapped" in claim 1.

Applicant notes that the lack of a literal basis in the specification is not sufficient to establish a *prima facie* case of failing to meet the written description requirement and believes that this is the case here. However, claim 1 has been amended to delete the above-noted recitation and recite that mapping the first representation to the second representation includes identifying and representing a correspondence between the first representation and the second representation using a set of data activities performed in accordance with a set of machine-readable instructions. Attention is respectfully directed to the description of the integration engine at page 9, line 3-5 of the Specification for support for the amendment. Accordingly, the amended language is fully supported and Applicant requests that the rejections under 35 U.S.C. § 112, first paragraph of claim 1 and the claims dependent therefrom be withdrawn.

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Rejections under 35 U.S.C. § 102(e)

The Advisory action appears to contend that the rejection of claim 1 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Publication 2002/0103881 to Granade et al. would be maintained.

Once again, applicant requests that the reasons for all rejections be set forth so that applicant may judge the propriety of continuing prosecution, as required by 37 C.F.R. § 1.104(2). In this regard, Applicant requests that the Examiner clearly identify where and how the Granade allegedly maps representations of data variable information, as recited in claim 1. Applicant also respectfully requests that the Examiner consider and respond to the remarks regarding to the 35 U.S.C. § 102(e) rejections of claims 2 and 3 set forth in the Reply filed April 27, 2006.

Accordingly, Applicant requests that the rejections of claim 1 and the claims dependent therefrom be withdrawn.

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

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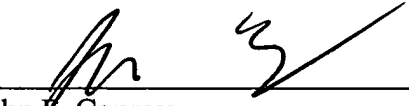
CONCLUSION

Applicants' attorney can be reached at the address shown above. Telephone calls regarding this application should be directed to 858-678-4346.

A check for fee for the Request for Continued Examination is enclosed. If any additional fees are due, please charge them to deposit account 06-1050, referencing Attorney Docket No. 13907-058001.

Respectfully submitted,

Date: May 24, 2006

  
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John F. Conroy  
Reg. No. 45,485

Fish & Richardson P.C.  
PTO Customer No. **32864**  
12390 El Camino Real  
San Diego, California 92130  
Telephone: (858) 678-5070  
Facsimile: (858) 678-5099

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